

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. OSTERBERG, TOREN S. DAVIS and CONOR D. JOHNSON

Appeal No. 2001-0472
Application No. 09/153,951

ON BRIEF

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 19 to 24, as amended subsequent to the final rejection.¹ These claims constitute all of the claims pending in this application.

¹ While the examiner has approved entry of the amendment after final rejection (Paper No. 6, filed May 19, 2000), we note that this amendment has not been clerically entered.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to tuned mass damping devices (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Sarazin	2,225,929	Dec. 24,
1940		

Claim 22 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the appellants, at the time the application was filed, had possession of the claimed invention.

Claims 19 to 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sarazin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed September 25, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed September 18, 2000) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The written description rejection

We sustain the rejection of claim 22 under 35 U.S.C. § 112, first paragraph.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

The examiner determined (answer, pp. 3-4) that the phrase "being at least one half of the predetermined length and less than the first length" recited in lines 5-6 and 9-10 of claim 22 did not find written description support in the original disclosure. The appellants argue (brief, pp. 9-11) that the above-noted phrase is inherent from the description on page 4, line 20 to page 5, line 9 taken together with Figure 2. The examiner responded (answer, pp. 7-8) to the appellants' argument by explaining why the above-noted phrase was not inherent from the original disclosure.

We find ourselves in agreement with the position of the examiner that the above-noted phrase is not inherent from the original disclosure. While the claimed grooves are inherently "less than the first length" for the reasons set forth by the appellants, the claimed grooves are not inherently "at least one half of the predetermined length" for the reasons set forth by the examiner. In that regard, it is our determination that Figure 2 shows that the relative movement between the moveable mass 110 and the cylindrical surface 112 is not limited to the distance the mass can move when the balls move from one end of their respective groove to the other end of their respective groove. That is, the mass can still move after the balls have reached either end of their respective grooves. Thus, we find that the claimed grooves are not inherently "at least one half of the predetermined length."

For the reasons set forth above, the decision of the examiner to reject claim 22 under 35 U.S.C. § 112, first paragraph, is affirmed.

The obviousness rejection

We will not sustain the rejection of claims 19 to 24 under 35 U.S.C. § 103.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish

obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellants. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999).

The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id.

In this case, the examiner ascertained (answer, p. 5) that the one difference between claims under appeal and Sarazin² is that "Sarazin does not teach the use of only one ball being located in each trough." We agree. In that regard, it is our determination that the claimed limitation of "a single ball" in each trough/groove means that only one ball can be located in each trough/groove.

² The teachings of Sarazin are set forth on pages 4-6 of the answer and pages 11-13 of the brief.

With regard to this difference, the examiner determined
(answer, pp. 5-6) that

it would have been obvious to one of ordinary skill in
the art at the time the invention was made to have
eliminated the cylinder of Sarazin in favor of providing
only one ball in separate troughs of the system in order
to reduce the overall number of parts in the system for
simplicity of design.

We do not agree.

We agree with the appellants' argument (brief, pp. 13-14)
that the claimed subject matter would not have been obvious at
the time the invention was made to a person of ordinary skill
in the art from the teachings of Sarazin. In that regard, we
note that in the rejection under 35 U.S.C. § 103 before us in
this appeal the examiner has not provided the necessary
evidence to support the examiner's above-noted obviousness
determination. That is, the applied prior art of Sarazin does
not suggest eliminating his cylinder 22 in favor of providing
only one ball in separate troughs of the system. In our view,
the only suggestion for modifying Sarazin in the manner
proposed by the examiner to arrive at the claimed subject
matter stems from hindsight knowledge derived from the

appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 19 to 24 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 22 under 35 U.S.C. § 112, first paragraph, is affirmed and the

decision of the examiner to reject claims 19 to 24 under
35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED-IN-PART

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 2001-0472
Application No. 09/153,951

Page 12

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Appeal No. 2001-0472
Application No. 09/153,951

Page 13

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